



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/687,072

10/16/2003

Kazuhiko Hasegawa

12413Z

8928

23389

7590

03/07/2006

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,072

Applicant(s)

HASEGAWA, KAZUHIKO

Examiner

Edwin C. Holloway, III

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/245,437.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2635

EXAMINER'S RESPONSE

1. In response to the application filed 10-16-03, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 102 & 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2635

4. Claim 1, 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara (US 5757279) in view of Sudo (US 599827 or 5856827).

Referring to claim 1, Fujiwara discloses the radio pager 10 comprising a display 20 for displaying a number of receiving information (Fig. 1). Fujiwara further disclose the pager comprising selecting means allowing a user of pager to select, by scrolling switches 21 and 22, either viewing of the information sequentially from an oldest one to a newest one or viewing the information sequentially from the newest one to the oldest one (col.1, line 66 - col. 2, line 6 and col. 6, line 54 - col.8, line 4). However, Fujiwara fails to disclose the switching of the scrolling direction responsive to rotation of a jog dial.

Sudo 5999827 discloses a wireless portable communication device having scrolling switch as a jog dial 4 (scrolling knob) for easily viewing the received information sequentially in ascending or descending order by rotation of the dial. Note up/down rotation of dial in fig. 2. Element 36J in fig. 7 is labeled a jog dial. Fig. 17 shows moving up or down in a list in response to up or down movement of the dial.

Sudo 5856827 discloses a device with a jog dial very similar to the patent in the previous paragraph. Figs. 12A-12G

Art Unit: 2635

show scrolling down from top to bottom of a list of items one item at a time in response to downward rotation of the dial. Figs. 14A-14G show that upward rotation of the dial initially jumps to the bottom of the list (fig. 14B) and then scrolls up one item at a time to the top of the list.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have changed direction of the display of received information responsive to rotating a jog dial in the pager of Fujiwara as evidenced by Sudo (5856827 or 5999827) because Fujiwara suggests the radio pager having means allowing user of pager to select, by scrolling switches, viewing of the information sequentially either from the newest to the oldest one or from the oldest to the newest one and Sudo teaches such the scrolling switch being a jog dial for easily viewing the received information sequentially in ascending or descending order.

Referring to claim 4, Fujiwara discloses the radio pager wherein the selecting means comprising receiving means 12 (radio wave receiving portion) for receiving radio wave, control means 17 (CPU) causing received information to display in ascending order or descending order, storing means 18 (storing portion), alerting means 33 (alerting portion) when received address number (identification code data) is identical with

Art Unit: 2635

identification code data stored in storage means (col. 5, line 52-59), operation control means 21 (scrolling direction selection switch) and 22 (scrolling switch) for causing the receiving information stored in storing means and to be read out in the ascending order or the descending order (Fig. 1).

Referring to claim 5, Fujiwara discloses the control having function for allowing user to search for any desired received information (first coming message or recently coming message) by turning the switch (col. 5, line 64 - col. 6, line 5).

Referring to claim 6, Fujiwara discloses the operation control means comprising an identifying section 22 (scrolling switch) for identifying the direction of rotation and a switch section 21 (scrolling direction selection switch) for setting either one of ascending order and descending order (col. 5, line 64 - col. 6, line 5). However, Fujiwara does not explicitly disclose the operation means having an adding section and subtracting section for adding or subtracting pulse output from switching section and feeding a resulting pulse addition or subtraction signal. Sudo 5999827 discloses the operation means 36J having means 36J21 and 36J22 (Fig. 15A and B) for adding (right-shifting) or subtracting (left-shifting) pulse output from switching section and feeding a result pulse addition or subtraction signal to the control means (Fig. 16A and B) for

Art Unit: 2635

displaying the received information in ascending or descending order. Sudo 5856827 has similar means/signals in figs. 4A-5B.

Furthermore, the claimed invention would perform equally well with the associated function as in the prior art. Both the adding or subtracting pulse output from the switching of the claim and right-shifting or left-shifting the outer circumference of the prior art accomplish the same result, viz., selecting option of scrolling to display the messages in ascending or descending order. The adding or subtracting pulse output from the switching appears to offer no advantage over the prior art's shifting the outer circumference pulse output. It makes no difference which arrangement is employed.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made of including adding and subtracting section for controlling of displaying receiving information in ascending or descending order in the device of Fujiwara as evidenced by Sudo because Fujiwara suggest the control means having scrolling direction selection switch and scrolling switch, and Sudo further teaches the scrolling direction selection switch having right-shifting or left-shifting the outer circumference for adding or subtracting pulse output from switching section and feeding a result pulse addition or subtraction signal to the control means for

Art Unit: 2635

displaying the received information in ascending or descending order. Furthermore, the claimed invention would perform equally well with the associated function as in the prior art. Both the adding or subtracting pulse output from the switching of the claim and right-shifting or left-shifting the outer circumference of the prior art accomplish the same result, viz., selecting option of scrolling to display the messages in ascending or descending order. The adding or subtracting pulse output from the switching appears to offer no advantage over the prior art's shifting the outer circumference pulse output. It makes not difference which arrangement is employed.

Referring to claim 8, Fujiwara fails to disclose the rotary switch including operating portion protruding from a side of radio pager. Sudo 5999827 shows the scrolling switch including operating portion 4 (scroll knob) protruding from a side of communication terminal, as an alternative to pager, for purpose of easiness of scrolling up and down. Sudo 5856827 labels this element 6J in figs. 1-3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made of having a operation portion protruding from a side of radio pager in the device of Fujiwara as evidenced by Sudo because Fujiwara suggest the radio pager having scrolling switch for scrolling up and down and Sudo

Art Unit: 2635

teaches the scrolling switch having operation portion protruding from a side of communication terminal, as an alternative to pager, for purpose of easiness of scrolling up and down.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara in view of Sudo (US 599827 or 5856827) as applied above and further view of Hidaka (US 5966113).

Fujiwara does not disclose the radio pager further comprising setting means for rearranging the received information on the basis of an information number, a confirmation flag, and a content to thereby allow the user to search for any desired information by turning rotate switch. Hidaka discloses the pager having selecting means (item code) for rearranging the received information on the basic of information number (priority number), confirmation flag (data distinction flag), and a content (name, address, or others) (Fig. 14 and col. 9, line 40 - col. 10, line 6) for enhancing on searching information based on different categories.

It would have been obvious to one of ordinary skill in the art at the time the invention was made of having a setting means for rearrange the received information on the basic of an information number, a confirmation flag, and a content in the

Art Unit: 2635

device of Fujiwara as evidenced by Hidaka because Fujiwara suggests the radio pager having means for selecting ascending order display or descending order display and Hidaka further teaches radio pager having setting means for rearranging the received information on the basis of information number, confirmation flag, and content of message for enhancing on searching information based on different categories.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara in view of Sudo (US 599827 or 5856827) and Hidaka as applied above and further in view of Shima (US 5652571).

Fujiwara does not explicitly disclose a setting means replacing the k th oldest confirmed message by the m th received message to the k th position when the storage area being full ($m=n+1$). Shima in the same field of endeavor discloses the system wherein the k th oldest confirmed message replaced by the m th received message at the k th confirmed position (step S13) when the storage area being full $m = n+1$ (step S4 and step S9) and store the m th message at m th position when the storage area is not full (step S8) for the purpose of increasing capability and efficiency of storing message when the storage area being full.

Art Unit: 2635

It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the oldest confirmed message by the received message at the oldest confirmed message position when the storage area being full in the device of Fujiwara as evidenced by Shima because Fujiwara suggests the pager having storage mean for storing multiple messages; and Shima in the same field of the endeavor teaches to replace the oldest confirmed message by the received message at the oldest confirmed message position when the storage area being full and stored at the vacant area when the storage area is not full for the purpose of increasing capability and efficiency of storing message when the storage area being full.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara in view of Sudo (US 599827 or 5856827) and Hidaka as applied above and further in view of and Yamaguti (US 6100813).

Fujiwara fails discloses content of the received information. Hidaka disclose the received information including personal information including telephone number personal and personal message (meeting place, comment) (Fig. 15) and shared information including news (stock price). Also Yamaguti further

Art Unit: 2635

discloses the received information including weather forecast (Fig. 2B).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include personal information and shared information in received message in the device of Fujiwara as evidenced by Hidaka and Yamaguti because Fujiwara suggests the radio pager having capability displaying multiple received information, Hidaka teaches received information including personal information including phone number and personal message and shared information as news, and Yamaguti further teaches shared information including weather forecast.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kunihiro (US 6021336) and Yanagida (US 6064877) disclose pagers with a rotary switch.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll

Art Unit: 2635

free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.


Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center at (866) 217-9197. On July 15, 2005, the Central FAX Number will change to.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (703) 308-1202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
3/4/06


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635